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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10.033

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on 5/27/08

Signature

Typed or printed name

JOHN McMAHON

Application Number

09/644,777

Filed

August 23, 2000

First Named Inventor

Roger P. Jackson

Art Unit

3732

Examiner

Candice Melson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 29,415

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

John C. McMahon
Signature

John C. McMahon

Typed or printed name

816-531-3470

Telephone number

5/27/08

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
STATEMENT IN SUPPORT OF REVIEW OF FINAL REJECTION

Applicant: Roger P. Jackson

Serial No.: 09/644,777

Date: May 27, 2008

Filed: August 23, 2000

Group Art Unit: 3732

Exam: Candice Melson

For: THREADFORM FOR MEDICAL IMPLANT CLOSURE

Kansas City, Missouri

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following is in support of applicant's Request of Review of the final action of the above captioned application.

The present application has passed through a torturous prosecution since filing on August 23, 2000. Included in the prosecution has been notice of the allowability of claims (for example, see action of June 3, 2003) and the withdrawal of such indication of allowability, as well as lengthy delays.

The present rejection is under 102(e) as anticipated by Morrison (6,296,642). It is readily accepted that the basic concept of Morrison is the same as that of the present application. However, applicant conceived of the invention prior

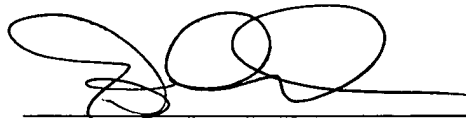
to Morrison and even disclosed the invention to Morrison's assignee through engineers of the assignee who were working with applicant and were located in applicant's office for a period of several years. This disclosure long predated Morrison even joining the assignee. Applicant also reduced the invention to practice prior to the filing of the Morrison application, as is supported by the various declarations and evidence previously filed in an attempt to "swear back" of the filing date of the Morrison application.

The Examiner has taken the position that the evidence submitted to date in multiple declarations is insufficient to establish a reduction to practice prior to the effective filing date of the Morrison reference. Applicant respectfully disagrees and believes that the evidence submitted does show a reduction to practice before the effective date of Morrison and requests review of the Examiner's decision prior to taking the matter to the Board of Appeals.

It is noted that a request has been made to the Examiner to explain why the evidence submitted to date has been insufficient so that applicant could either supplement the record, if additional information or evidence were found to be available, or so that applicant could rebut the Examiner's position; however, no such explanation has been provided.

Review and reconsideration of the decision of December 26, 2007 is respectfully requested.

Respectfully Submitted,




John C. McMahon
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May 27, 2008.

Roger P. Jackson
(Applicant)

By



May 27, 2008

(Date of Signature)